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OFFICE OF PETITIONS

PATENT DEPARTMENT (51851)
KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM NC 27101

In re Application of	:	
Alexander et al.	:	
Application No. 10/657,145	:	ON APPLICATION FOR
Filed: September 9, 2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No. IMMR-	:	
IMD0002D(434701-005	:	
Title: INTERFACE DEVICE AND	:	
METHOD FOR INTERFACING	:	
INSTRUMENTS TO MEDICAL	:	
PROCEDURE SIMULATION SYSTEMS	:	

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" filed April 23, 2010. Applicants request that the determination of patent term adjustment be corrected from one hundred ninety-one (191) days to one thousand one hundred twenty-eight (1,128) days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under §

1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

notice of allowance, the application for patent term adjustment is **GRANTED**.

On January 26, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 191 days. The instant application for patent term adjustment was timely filed on April 26, 2010.

Applicants state that the 31 day adjustment pursuant to 37 CFR 1.703(a)(3) should be removed and a 61 day reduction pursuant to 37 CFR 1.704(b) is required for the submission of the May 13, 2005 reply.

The Office has considered applicants' argument and finds it persuasive. A review of the record shows that in response to the final Office action mailed on December 13, 2004, an amendment which reopened prosecution was not filed until May 13, 2005. 37 CFR §1.704(b) provides:

an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

Pursuant to 37 CFR 1.704(b), a reduction of 61 days is required for applicant delay for the period beginning March 14, 2005, the day after the date that is three months after the mailing of the final Office action and ending on May 13, 2005, the date the reply was filed. The 4 day reduction will be removed and replaced with a 61 day reduction.

Based upon the fact that a response to the final Office action was received on May 13, 2005 and not March 17, 2005 a 31 day

adjustment is not warranted as the August 17, 2005 Office action was mailed within four months pursuant to 37 CFR 1.703(a)(2).

Applicants delay totals 169 (4 + 61 + 3 + 5 + 5 + 62 + 29) days.
Office delay totals 272 (265 + 7) days.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is one hundred three (103) days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM Screen



[PTA/PTE Information](#)
[Patent Term Adjustment](#)
[Patent Term Extension](#)

Application Number*:
[Explanation of PTA Calculation](#)
[Explanation of PTE Calculation](#)

PTA Calculations for Application: 10657145

Application Filing Date	09/09/2003	OverLapping Days Between (A and B) or (A and C)	0
Issue Date of Patent		Non-Overlapping USPTO Delays:	303
A Delays	303	PTO Manual Adjustment	-88
B Delays	0	Applicant Delay (APPL)	112
C Delays	0	Total PTA (days)	103

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
120	08/28/2010		P028	Adjustment of PTA Calculation by PTO		88	0
105	01/26/2010		MN/=.	Mail Notice of Allowance			0
104	01/21/2010		IREV	Issue Revision Completed			0
103	01/21/2010		DVER	Document Verification			0
102	01/21/2010		N/=.	Notice of Allowance Data Verification Completed			0

101	01/19/2010		EX.A	Examiner's Amendment Communication		0
100	01/19/2010		CNTA	Notice of Allowability		0
92	10/15/2009		FWDX	Date Forwarded to Examiner		0
90	10/15/2009		FWDX	Date Forwarded to Examiner		0
88	10/15/2009		ABN9	Disposal for a RCE / CPA / R129		0
97	10/08/2009		IDSC	Information Disclosure Statement considered		0
96	10/08/2009		IDSC	Information Disclosure Statement considered		0
95	10/08/2009		M844	Information Disclosure Statement (IDS) Filed		0
94	10/08/2009		RCAP	Reference capture on IDS		0
93	10/08/2009		M844	Information Disclosure Statement (IDS) Filed		0
91	10/08/2009		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE		0
89	10/08/2009	09/09/2009	RCEX	Request for Continued Examination (RCE)	<u>29</u>	83
87	10/08/2009		XT/G	Request for Extension of Time - Granted		0
86	10/08/2009		WIDS	Information Disclosure Statement (IDS) Filed		0
85	10/08/2009		WIDS	Information Disclosure Statement (IDS) Filed		0
84	10/08/2009		BRCE	Workflow - Request for RCE - Begin		0
83	06/09/2009		MCTFR	Mail Final Rejection (PTOL - 326)		0
82	06/08/2009		CTFR	Final Rejection		0
81	05/14/2009		PA..	Change in Power of Attorney (May Include Associate POA)		0
80	05/11/2009		C.AD	Correspondence Address Change		0
79	03/11/2009		FWDX	Date Forwarded to Examiner		0
78	03/02/2009	12/30/2008	A...	Response after Non-Final Action	<u>62</u>	75
77	03/02/2009		XT/G	Request for Extension of Time - Granted		0
76	10/08/2008		DOCK	Case Docketed to Examiner in GAU		0
75	09/30/2008		MCTNF	Mail Non-Final Rejection		0
74	09/26/2008		CTNF	Non-Final Rejection		0
73	08/25/2008		FWDX	Date Forwarded to Examiner		0
72	08/05/2008		A.NE	Amendment after Final Rejection		0
71	07/10/2008	07/03/2008	MCTFR	Mail Final Rejection (PTOL - 326)	<u>7</u>	67
70	07/07/2008		CTFR	Final Rejection		0
68	05/05/2008		FWDX	Date Forwarded to Examiner		0
69	03/03/2008		IDSC	Information Disclosure Statement		0

			considered		
67	03/03/2008	02/27/2008 A...	Response after Non-Final Action	<u>5</u>	63
66	03/03/2008	RCAP	Reference capture on IDS		0
65	03/03/2008	M844	Information Disclosure Statement (IDS) Filed		0
64	03/03/2008	WIDS	Information Disclosure Statement (IDS) Filed		0
63	11/27/2007	MCTNF	Mail Non-Final Rejection		0
62	11/26/2007	CTNF	Non-Final Rejection		0
61	09/18/2007	FWDX	Date Forwarded to Examiner		0
60	09/10/2007	09/05/2007 A...	Response after Non-Final Action	<u>5</u>	59
59	06/05/2007	MCTNF	Mail Non-Final Rejection		0
58	05/29/2007	CTNF	Non-Final Rejection		0
57	03/26/2007	FWDX	Date Forwarded to Examiner		0
56	03/14/2007	03/11/2007 A...	Response after Non-Final Action	<u>3</u>	55
55	12/11/2006	03/21/2006 MCTNF	Mail Non-Final Rejection	<u>265</u>	46
54	11/27/2006	CTNF	Non-Final Rejection		0
51	10/17/2006	DOCK	Case Docketed to Examiner in GAU		0
50	10/12/2006	DOCK	Case Docketed to Examiner in GAU		0
49	04/26/2006	C.ADB	Correspondence Address Change		0
47	11/30/2005	FWDX	Date Forwarded to Examiner		0
53	11/21/2005	IDSC	Information Disclosure Statement considered		0
48.7	11/21/2005	11/21/2005 M844	Information Disclosure Statement (IDS) Filed		46
48	11/21/2005	WIDS	Information Disclosure Statement (IDS) Filed		0
46	11/21/2005	11/17/2005 A...	Response after Non-Final Action	<u>4</u>	43
52	10/31/2005	IDSC	Information Disclosure Statement considered		0
45.7	10/31/2005	M844	Information Disclosure Statement (IDS) Filed		0
45	10/31/2005	WIDS	Information Disclosure Statement (IDS) Filed		0
44	10/06/2005	DOCK	Case Docketed to Examiner in GAU		0
43	08/17/2005	07/17/2005 MCTNF	Mail Non-Final Rejection	<u>31</u>	31
42	08/16/2005	CTNF	Non-Final Rejection		0
40	07/27/2005	DOCK	Case Docketed to Examiner in GAU		0
39	05/23/2005	FWDX	Date Forwarded to Examiner		0
36	05/23/2005	C.AD	Correspondence Address Change		0

35	05/23/2005	PA..	Change in Power of Attorney (May Include Associate POA)	0
34	03/31/2005	MCTAV	Mail Advisory Action (PTOL - 303)	0
33	03/30/2005	CTAV	Advisory Action (PTOL-303)	0
32	03/24/2005	FWDX	Date Forwarded to Examiner	0
30	03/24/2005	C.AD	Correspondence Address Change	0
29	03/24/2005	PA..	Change in Power of Attorney (May Include Associate POA)	0
28	03/24/2005	C.AD	Correspondence Address Change	0
31	03/17/2005	03/13/2005 A.NE	Amendment after Final Rejection	<u>4</u> 26
38	03/13/2005	A.NE	Amendment after Final Rejection	0
37	03/13/2005	XT/G	Request for Extension of Time - Granted	0
27	12/13/2004	MEXIN	Mail Examiner Interview Summary (PTOL - 413)	0
26	12/13/2004	MCTFR	Mail Final Rejection (PTOL - 326)	0
25	12/09/2004	CTFR	Final Rejection	0
24	10/05/2004	TSSCOMP	IFW TSS Processing by Tech Center Complete	0
20	10/05/2004	FWDX	Date Forwarded to Examiner	0
41	09/15/2004	IDSC	Information Disclosure Statement considered	0
22	09/15/2004	RCAP	Reference capture on IDS	0
21.7	09/15/2004	09/15/2004 M844	Information Disclosure Statement (IDS) Filed	19
21	09/15/2004	WIDS	Information Disclosure Statement (IDS) Filed	0
19	09/15/2004	A...	Response after Non-Final Action	0
18	09/15/2004	WAMD	Workflow incoming amendment IFW	0
17	08/17/2004	EXIN	Examiner Interview Summary Record (PTOL - 413)	0
16	06/15/2004	MCTNF	Mail Non-Final Rejection	0
15	06/14/2004	CTNF	Non-Final Rejection	0
14	02/27/2004	DOCK	Case Docketed to Examiner in GAU	0
23	01/09/2004	RQPR	Request for Foreign Priority (Priority Papers May Be Included)	0
13	01/09/2004	A.PE	Preliminary Amendment	0
11	12/16/2003	TI1050	Transfer Inquiry to GAU	0
10	12/08/2003	WROIPE	Application Return from OIPE	0
9	12/08/2003	COMP	Application Is Now Complete	0
8	12/08/2003	ROIPE	Application Return TO OIPE	0
7	12/08/2003	COMP	Application Is Now Complete	0

6	12/08/2003	OIPE	Application Dispatched from OIPE	0
5	12/08/2003	COMP	Application Is Now Complete	0
4	11/21/2003	CLSS	CASE CLASSIFIED BY OIPE	0
3	11/21/2003	L194	Cleared by OIPE CSR	0
2	10/12/2003	SCAN	IFW Scan & PACR Auto Security Review	0
12	09/09/2003	A.PE	Preliminary Amendment	0
1	09/09/2003	IEXX	Initial Exam Team nn	0

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